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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Attorney Docket No. AUS920010152US1

IN RE APPLICATION OF:

Dutta, et al

Serial No. 09/817,100

Filed: March 26, 2001

For: THIRD PARTY MERCHANDISE
RETURN SYSTEM

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Examiner: Matthew S. Gart

Art Unit: 3625

APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Brief is submitted in triplicate in support of the Appeal in
the above-identified application.

**CERTIFICATE OF MAILING
37 CFR 1.8(a)**

I hereby certify that this correspondence is being deposited with the United States Postal Service as First-Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on the date below:

June 9, 2004
Date

[Signature]
Signature

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I. With regard to the rejection of claims 1-2, 8-12 and 18-22 under 35 USC 102(e) over Tsunenari, it is submitted that Tsunenari does not teach or even suggest a method for processing a return of an item purchased from a selling merchant by a remote customer, which includes receiving an order which includes customer-related information, for an item being purchased, storing the customer-related information in a storage device, sending the item to the customer from the selling merchant, receiving a return communication from the customer requesting to return the item to the selling merchant, retrieving the customer-related information from the storage device and sending to the customer a shipping communication including portions of the retrieved customer-related information and identifying a receiving entity other than the selling merchant to whom the item is to be returned.	

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78		
79	II. With regard to the rejection of claims 3-7, 13-17 and	
80	23-25, under 35 USC 103(a) over Tsunenari in view of Siegel, it	
81	is respectfully submitted that there is no basis, suggestion or	
82	nexus for the hypothetical combination of Tsunenari and Siegel	
83	and that even the hypothetical combination of Tsunenari and	
84	Siegel does not teach, suggest or render obvious, the present	
85	invention as recited in the noted claims.	11
86		
87		
88	CONCLUSION	12
89		
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92		

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93 REAL PARTY IN INTEREST

94
95 The present application is assigned to International Business
96 Machines Corporation, the real party in interest.
97

98
99 RELATED APPEALS AND INTERFERENCES

100
101 No related appeal is presently pending.
102
103

104 STATUS OF THE CLAIMS

105
106 Claims 1-25 are pending and stand finally rejected by the
107 Examiner as noted in the Final Office Action mailed March 22,
108 2003.
109
110

111 STATUS OF AMENDMENTS

112
113 Prior to the Final Office Action (mailed 3/22/03), there was only
114 one Office Action mailed 10/31/03 and one Amendment mailed
115 1/31/04. The Second and Final Office Action re-asserted the 35
116 USC 102(e) and 35 USC 103(a) rejections as stated in the 10/31/03
117 Office Action but withdrew the 35 USC 101 and 35 USC 112
118 rejections. The last entered amendment was submitted 1/31/04
119 which amended the claims to the text shown in the Appendix.
120

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121
122 **SUMMARY OF THE INVENTION**
123

124 The present application discloses a method and implementing
125 system in which merchants are enabled to designate re-seller
126 return locations to customers for returned items. In an exemplary
127 embodiment, a merchant is notified that a customer wishes to
128 return an item purchased. The merchant then sends the customer a
129 return label for the returned item containing the address of the
130 re-seller for the merchant. The re-seller then notifies the
131 merchant when the item has been received and the merchant then
132 credits the account of the customer for the returned item. In a
133 second exemplary embodiment, upon receipt of notice from the
134 customer of the return, the merchant then makes the item
135 available for an auction purchase to a number of re-seller
136 merchants or individuals. When a winning bid is known to the
137 merchant, the return address of the winning bidder is then sent
138 to the customer for use in returning the purchased item.

139
140 The above methodology is set forth in pending claim 1, which
141 recites:

142
143 "1. A method for processing a return of an item purchased from a selling merchant by a remote
144 customer, said method comprising:

145
146 receiving an order for said item from said customer, said order including customer-related
147 information;

148
149 storing said customer-related information in a storage device;

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150
151 sending said item to said customer by said selling merchant;
152
153 receiving a return communication from said customer requesting a return of said item to said
154 selling merchant;
155
156 retrieving said customer-related information from said storage device; and
157
158 sending a shipping communication including portions of said customer-related information to said
159 customer, said shipping communication identifying a receiving entity other than said selling
160 merchant to whom said item is to be returned."

161
162
163 **ISSUES**
164

165 1. Is the Examiner's rejection of claims 1-2, 8-12 and 18-22
166 under 35 USC 102(e) as being anticipated by the Tsunenari Patent
167 Application Publication US 2002/0013744 (hereinafter referred to
168 as "Tsunenari") well founded?
169

170 2. Is the Examiner's rejection of claims 3-7, 13-17 and 23-25
171 under 35 USC 103(a) as being unpatentable over Tsunenari in view
172 of the Siegel Patent Application Publication US 2001/0032147
173 (hereinafter referred to as "Siegel") well founded and is the
174 hypothetical combination of Tsunenari and Siegel suggested by
175 either reference?
176
177
178

179 GROUPING OF THE CLAIMS

180
181 For purposes of this Appeal, independent claim 1 and claims 2-10,
182 which ultimately depend from claim 1, comprise a group of various
183 combinations of the claimed methodology; independent claim 11 and
184 claims 12-20, which ultimately depend from claim 11, comprise a
185 medium embodiment generally corresponding to claims 1-10; and
186 claim 21, and claims 22-25 which ultimately depend from claim 21,
187 define a processing system embodying the disclosed methodology.
188

189
190 ARGUMENT
191

192 I. With regard to the rejection of claims 1-2, 8-12 and 18-
193 22 under 35 USC 102(e) over Tsunenari, it is submitted that
194 Tsunenari does not teach or even suggest a method for processing
195 a return of an item purchased from a selling merchant by a remote
196 customer, which includes receiving an order, including customer-
197 related information, for an item being purchased, storing the
198 customer-related information in a storage device, sending the
199 item to the customer from the selling merchant, receiving a
200 return communication from the customer requesting to return the
201 item to the selling merchant, retrieving the customer-related
202 information from the storage device and sending to the customer a
203 shipping communication including portions of the retrieved
204 customer-related information and identifying a receiving entity
205 other than the selling merchant to whom the item is to be
206 returned.
207

208 All of the above limitations and relationships are included in
209 the broadest claims 1, 11 and 21 and clearly disclosed and
210 supported in the specification and drawings. Tsunenari falls
211 short of disclosing several of the above-recited limitations.
212 Tsunenari discloses a server system which effects the return of a
213 consumer product by a third party. Although paragraphs 0013-0018
214 of Tsunenari are cited by the Examiner as disclosing "receiving
215 an order", and "sending said item", it is noted that there is no
216 mention in any of the cited paragraphs regarding the receiving of
217 an order or the sending of an item **as those steps are**
218 **specifically set forth in the claims.** Rather, Tsunenari discloses
219 a return system that does not necessarily involve a selling
220 merchant at the front end but rather begins when a client sends a
221 return notice to an independent agency. That is why the return
222 agency must send one or more form pages to the client to gather
223 client-related information. Tsunenari teaches, **as a necessary**
224 **element,** the use of a network server **presenting to a client one**
225 **or more form pages adapted to elicit consumer information**
226 including an identification of the consumer product to be
227 returned and an identification of the present location of the
228 consumer product. The form pages are presented to the consumer
229 after the server receives a communication that the consumer
230 wishes to return a product. Thus, a customer must first send
231 notice to an agency server that the customer wishes to return a
232 product and this request is then followed by the sending of "one
233 or more form pages" back to the customer to completed by the
234 customer who then must again send the completed forms back to the
235 returning agency server (and make further corrections as may be
236 required by further communications) before the return process can
237 continue. The present invention, by contrast, needs only to

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238 retrieve customer-related information that is already in storage
239 at the server thereby obviating the need for the customer to
240 complete "one or more form pages" and process at least two more
241 communication transactions. The present invention thereby
242 significantly accelerates and facilitates the return process by
243 storing the customer-related information at a server site when a
244 sale is made and having that information available at the server
245 site for immediate retrieval if a return request is made by a
246 customer.

247
248 More specifically, the broadest claims 1, 11 and 21 recite, *inter*
249 *alia*:

250
251 "receiving an order for said item from said customer, said order
252 including customer-related information" - Tsunenari does not
253 disclose the specified receiving of an order;

254
255 "storing said customer-related information in a storage device" -
256 Tsunenari does not disclose the specified storing of customer-
257 related information following the receipt of an order;

258
259 "sending said item to said customer by said selling merchant" -
260 Tsunenari does not disclose the specified sending of a purchased
261 item to a customer from the selling merchant;

262
263 "receiving a return communication from said customer requesting a
264 return of said item to said selling merchant" - Tsunenari does
265 not disclose the specified receiving of return communication by
266 the selling merchant (Tsunenari discloses only a receipt of
267 customer information by a third party);

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268
269 "retrieving said customer-related information from said storage
270 device" - Tsunenari does not disclose the specified retrieving of
271 customer information from the merchant's storage device - in fact
272 Tsunenari does not disclose the retrieval of customer information
273 from any pre-existing database; and
274
275 "sending a shipping communication including portions of said
276 customer-related information to said customer, said shipping
277 communication identifying a receiving entity other than said
278 selling merchant to whom said item is to be returned" - Tsunenari
279 does not disclose the specified sending of a shipping
280 communication including portions of the customer-related
281 information as defined in the claim as being customer-related
282 information that was stored at the time the order was placed and
283 retrieved by the merchant when a return was requested.
284
285 Lacking at least the above-noted seven distinct claimed elements,
286 and the recited specific relationships among those elements, it
287 is submitted that Tsunenari can not be said to anticipate the
288 independent claims 1, 11 and 21 of the present application.
289 Further, since dependent claims 2, 8-10, 12, 18-20 and 22,
290 ultimately depend from one of independent claims 1, 11 or 21, and
291 include all of the limitations of the respective independent
292 claim in addition to even further limitations as recited in the
293 individual dependent claims, it is clear that claims 2, 8-10, 12,
294 18-20 and 22-25 are also not anticipated by Tsunenari. Thus, it
295 is submitted that claims 1-2, 8-12 and 18-22 are allowable under
296 35 USC 102(e) over Tsunenari.
297

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298 II. With regard to the rejection of claims 3-7, 13-17 and
299 23-25, under 35 USC 103(a) over Tsunenari in view of Siegel, it
300 is noted that Siegel, like Tsunenari, discloses a third party
301 return system which also requires the gathering of initial
302 transaction information by the third party from a purchaser of a
303 remotely purchased product, a step that is rendered redundant and
304 unnecessary by the present invention since, with the present
305 invention, the customer-related information is already stored by
306 the merchant at the time of the sale and later retrieved from the
307 merchant's database when a return is requested. Siegel is cited
308 to disclose disjointed bits and pieces of the specified dependent
309 claims without regard for the total combination of claimed
310 elements and relationships as set forth in the dependent claims
311 of the present application, in combination with the limitations
312 of the intervening dependent claims and the referenced
313 independent claim. Even a direct substitution of Siegel into the
314 Tsunenari system (for which there is no suggestion in either
315 reference) would fall short of disclosing or teaching at least
316 the same specifically claimed elements and relationships as
317 discussed above, and so, even if the proposed combination of
318 Tsunenari and Siegel was suggested by one of the references
319 (which it is not), the proposed combination would still not
320 render claims 3-7, 13-17 and 23-25 obvious since at least the
321 seven claimed elements and relationships among those elements as
322 hereinbefore stated, are still missing even from a combination of
323 Tsunenari and Siegel.

324
325 Further, it is submitted that there is no suggestion or reason in
326 either Tsunenari or Siegel for the combination of the two
327 references for any purpose. Thus lacking any reason, nexus or

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suggestion in either of the references for the proposed hypothetical combination, it is respectfully submitted that the combination of Tsunenari and Siegel is not a proper combination of references, and is not suggested by either reference. Rather, it is submitted that the only possible suggestion for the hypothetical combination of Tsunenari and Siegel can be found in applicant's disclosure, which cannot be used to reject applicant's own claims. Thus it is submitted that there is no basis in either Tsunenari or Siegel for the proposed combination under 35 USC 103(a).

Further, even a hypothetical combination of Tsunenari and Siegel does not render the present invention (as set forth in claims 3-7, 13-17 and 23-25, together with the further limitations set forth in the respective intervening and independent claims) obvious under 35 USC 103(a) since such a combination of references still lacks the disclosure of the specifically recited combination of elements and relationships as noted above.

It is therefore submitted that claims 3-7, 13-17 and 23-25 are allowable under 35 USC 103(a) over Tsunenari in view of Siegel.

CONCLUSION

For the reasons stated above, applicant urges the Board to consider that neither Tsunenari nor Siegel, alone or in combination, discloses or even suggests a method or system for processing a return of an item purchased from a selling merchant by a remote customer, which includes the entire combination of

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receiving an order for an item to be purchased with the order including customer-related information, storing the customer-related information in a storage device, sending the item to the customer from the selling merchant, receiving a return communication from the customer requesting to return the item to the selling merchant, retrieving the customer-related information from the storage device and sending to the customer a shipping communication including portions of the retrieved customer-related information and identifying a receiving entity other than the selling merchant to whom the item is to be returned, as those functions and relationships are set forth in the pending claims 1-25.

Consequently, applicant urges that the rejections of claims 1-2, 8-12 and 18-22 under 35 USC 102(e) as being anticipated by the Tsunenari, and claims 3-7, 13-17 and 23-25 under 35 USC 103(a) as being unpatentable over Tsunenari in view of the Siegel, are not well-founded and should be reversed.

Please charge IBM Corporation Deposit Account No. 09-0447 in the amount of \$330.00 for submission of a Brief in Support of Appeal. No additional fee or extension of time is believed to be required; however, in the event an additional fee or extension of time is required, please charge the fee, as well as any other fee necessary to further the prosecution of this application, to the

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387 above-identified deposit account.

388

389 Respectfully submitted,

390

391

392

393

A handwritten signature in black ink, appearing to read "Robert V. Wilder", is written over a horizontal line.

394 Robert V. Wilder (Tel:512-246-8555)

395 Registration No. 26,352

396 Attorney at Law

397 4235 Kingsburg Drive

398 Round Rock, Texas 78681

399

400 ATTORNEY FOR APPLICANT

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APPENDIX

1. A method for processing a return of an item purchased from a selling merchant by a remote customer, said method comprising:

receiving an order for said item from said customer, said order including customer-related information;

storing said customer-related information in a storage device;

sending said item to said customer by said selling merchant;

receiving a return communication from said customer requesting a return of said item to said selling merchant;

retrieving said customer-related information from said storage device; and

sending a shipping communication including portions of said customer-related information to said customer, said shipping communication identifying a receiving entity other than said selling merchant to whom said item is to be returned.

2. The method as set forth in claim 1 and further including:

receiving a return receipt notice from said receiving entity when said item has been received by said receiving entity.

430
431
432 3. The method as set forth in claim 2 wherein said method further
433 includes:
434
435 charging a designated customer account after receiving said
436 order.
437
438 4. The method as set forth in claim 3 and further including
439 crediting said customer account after receiving said return
440 receipt notice from said receiving entity.
441
442 5. The method as set forth in claim 4 and further including
443 sending notice of said crediting to said customer.
444
445 6. The method as set forth in claim 1 and further including:
446
447 effecting an auction of said item following said receiving of
448 said return communication from said customer, said receiving
449 entity being a winner of said auction.
450
451 7. The method as set forth in claim 1 and further including
452 maintaining a database for storing information concerning said
453 customer, said item and said receiving entity, said database
454 being updated upon receipt of an order, a return request or a
455 return receipt notice.
456
457

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458 8. The method as set forth in claim 1 wherein said receiving of
459 said return request and said sending of said shipping
460 communication are accomplished by email communication.

461
462 9. The method as set forth in claim 8 wherein said return receipt
463 notice is accomplished by email.

464
465 10. The method as set forth in claim 4 wherein said notice of
466 said crediting is accomplished by email.

467
468 11. A storage medium including machine readable coded indicia,
469 said storage medium being selectively coupled through a reading
470 device to processing circuitry within a computing system, said
471 reading device being selectively operable to read said machine
472 readable coded indicia and provide program signals representative
473 thereof, said program signals being effective to process a return
474 of an item purchased by a customer, said program signals being
475 selectively operable to accomplish the steps of:

476
477 receiving an order for said item from said customer, said order
478 including customer-related information;

479
480 storing said customer-related information in a storage device;

481
482 effecting a sending of said item to said customer by said selling
483 merchant;

484
485 receiving a return communication from said customer requesting a

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486 return of said item to said selling merchant;
487
488 retrieving said customer-related information from said storage
489 device; and
490
491 sending a shipping communication including portions of said
492 customer-related information to said customer, said shipping
493 communication identifying a receiving entity other than said
494 selling merchant to whom said item is to be returned.
495
496 12. The medium as set forth in claim 11 wherein said program
497 signals are further operable for:
498
499 effecting a receipt a return receipt notice from said receiving
500 entity when said item has been received by said receiving entity.
501
502 13. The medium as set forth in claim 12 wherein said program
503 signals are further operable for:
504
505 effecting a charging a designated customer account after
506 receiving said order.
507
508 14. The medium as set forth in claim 13 wherein said program
509 signals are further operable for effecting a crediting of said
510 customer account after receiving said return receipt notice from
511 said receiving entity.
512
513

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514 15. The medium as set forth in claim 14 wherein said program
515 signals are further operable for effecting said sending of said
516 notice of said crediting to said customer.

517
518 16. The medium as set forth in claim 11 wherein said program
519 signals are further operable for effecting an initiation of an
520 auction of said item following said receiving of said return
521 communication from said customer, said receiving entity being a
522 winner of said auction.

523
524 17. The medium as set forth in claim 11 and further including
525 maintaining a database for storing information concerning said
526 customer, said item and said receiving entity, said program
527 signals being further operable for updating said database upon
528 receipt of an order, a return request or a return receipt notice.

529
530 18. The medium as set forth in claim 11 wherein said receiving of
531 said return request and said sending of said shipping
532 communication are accomplished by email communication.

533
534 19. The medium as set forth in claim 18 wherein said return
535 receipt notice is accomplished by email.

536
537 20. The medium as set forth in claim 14 wherein said notice of
538 said crediting is accomplished by email.

542 21. A processing system including a system bus, a processor, a
543 memory system, and a network interface, all coupled to said
544 system bus, said processing system being operable in response to
545 an item return program being executed from said memory system for
546 effecting a return of an item purchased from a selling merchant
547 by a customer at a remote location through said network
548 interface, said processing system being selectively operable to
549 receive an order for said item from said customer over said
550 network interface, said order including customer-related
551 information, storing said customer-related information in said
552 memory system, and effecting a sending of said item to said
553 customer by said selling merchant, said processing system being
554 further operable for receiving a return communication from said
555 customer requesting a return of said item to said selling
556 merchant, retrieving said customer-related information from said
557 memory system, and sending a shipping communication including
558 portions of said customer-related information to said customer,
559 said shipping communication identifying a receiving entity other
560 than said selling merchant to whom said item is to be returned.

561
562 22. The system as set forth in claim 21 and further including:
563
564 receiving a return receipt notice from said receiving entity
565 through said network interface when said item has been received
566 by said receiving entity.

570 23. The system as set forth in claim 22 wherein said method
571 further includes:
572
573 charging a designated customer account in said memory system
574 after receiving said order.
575
576 24. The system as set forth in claim 23 and further including
577 crediting said customer account in said memory system after
578 receiving said return receipt notice from said receiving entity.
579
580 25. The system as set forth in claim 24 wherein said system is
581 further operable to effect a sending of a notice of said
582 crediting to said customer through said network interface.

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